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| BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001 | | | SMITH, TRACI L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,953

Applicant(s)

STIRPE ET AL.

Examiner

Traci L Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the length exceeds the maximum 150 words allowed. Correction is required. See MPEP § 608.01(b).
2. The attempt to incorporate subject matter into this application by reference to US Serial Number 09/469/02 is improper because application has been abandon and not related to current application. It is further improper because it has an incomplete application number.
3. The specification is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. There are also several errors within the specification such as misspellings and blank sections where the examiner believes information was intended to be added. See paragraphs 96, 124 and 133 as examples.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 44-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention de-identification. The specifications incorporation by reference for de-identification is improper and insufficient to give a detailed explanation of how de-identification works. Because the incorporation by reference is incomplete the examiner is unable to review information describing de-identification and it is not further explain in the specification the examiner is unable to understand the purpose or process of de-identification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9 and 10 are rejected as they recite the limitation "said display" in the first line of both claims. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim fails to define analytics console.

Claim Rejections - 35 USC § 101

9. Claims 19-39, 45-46 and 52-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

10. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case there is not a computer or electronic process required to accomplish the steps set forth by the claims. It is suggested to amend the claims to read on a computer system or electronic process.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-15, 18-19, 21-23, 25-50, 52-53 and 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,151,584 Papierniak et al.

13. As to claims 1, 19, 31, 40-41, 47, 52, and 57 a system and method providing personalized content to a user comprising of storage, categorizing and grouped

according to relatedness and analysis of data. ***Papierniak et al. Discloses a method of capture with enhanced analysis techniques to exploit vast information through uses of the web...results allow better (statistical) decisions.*** (C.3 l. 20-25)

14. As to claims 2-4, ***the data in the warehouse...usually subject-oriented such as customer, product, activity.*** (C. 14 l. 55-58)

15. As to claims 5, 28 and 37 ***formatted file library provides the intermediate classifications such as process characterizations, customer preferences, preference determination and behavior patterns.*** (C. 18 l. 45-48)

16. As to claims 6,32-33, 43, 49 and 56, ***websmart is intend to provide the best possible knowledge for customers.*** (C.18 l. 6-7)

17. As to claims 7, 9-10, 26-27 and 35-36 ***a display for displaying information to a computer user.*** (C. 10 l. 45-46, Fig. 4 Ref. 12)

18. As to claims 8, 25, 34, 42, 48, 55 and 58, ***involves parsing, categorizing, indexing and formatting the collected data.*** (C. 13 l. 17-18)

19. As to claims 11, 29 and 38 ***to collect data which indicates where a user has been in prior sessions.*** (C. 2 l. 65-66)

20. As to claim 12, ***Source data*** (Sheet 13 Fig. 13, bottom left corner)

21. As to claim 13 ***visitor profile data...depends on how much information the visited applications can entice the visitor to provide.*** (C. 15l. 47-49)

22. As to claim 14, ***data mining tools enable the present invention to discover hidden knowledge from existing data and information.*** (18 l, 65-67)

23. As to claim 15, ***wherein the multiple client browsers or clients are capable of accessing a server or web server storing information.*** (C.26 l.49-50)
24. As to claims. 18, 30, 39, 50 and 53, ***web warehouse is preferably time-stamped and associated with a defined period...subject oriented such as customer, product, activity.*** (C14. 56-61)
25. As to claims 21-23 ***metadata defines the data views necessary to produce the outputs required for decision support.*** (C. 15 l. 54-56)
26. As to claims 44-46, as best understood by the examiner, ***deletion of data in the web warehouse in an appropriate time.*** (C. 15 l. 65-67)

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 20, 24, 51, 54 and rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak et al as applied to claim 1-15, 18-19, 21-23, 25-50, 52-53 and 55-58 above, and further in view of Financialengines.com(any linkage Oct. 12, 1999).
29. As to claim 20, Papierniak fails to teach a step for drawing conclusions, financial engines.com teaches a ***powerful simulation technology then forecasts what their actual investments might be.*** (Pg. 23 l. 29-30). It would have been obvious to one

skilled in the art to incorporate the conclusion process into Papierniak so as to give the customer useful information.

30. As to Claim 24, Papierniak fails to teach a display method for the of what the gathered information means. Financialengines.com teaches ***how your decisions and advisor fund recommendations affect your future.***(P. 7 l. 4-7) See also Pg. 6 Fig. 2. It would have been obvious to one skilled in the art to incorporate the display method of financialengines.com to allow to the customer to see where they fit into the financial picture.

31. As to claims 51, 54 and 59, Papierniak fails to teach comparison method, financialengines.com teaches a ***retirement income projection is compared to your goal on a scenario by scenario basis.*** (Pg. 17 l.6-7) It would have been obvious to one skilled in the art to incorporate the teachings of comparison into Papierniak so as to allow the customer the ability to make an accurate decision of one product over another.

32. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papierniak et al as applied to claims 1-15, 18-19, 21-23, 25-50, 52-53 and 55-58 above, and further in view of Medscape.com(retrieved 7/9/04 any linkage February 29. 2000).

33. As to claims 16-17, Papierniak fails to teach display of related information. Medscapes.com ***medscape discloses a personal Medscape homepage from an assortment of specialty sites ...automatically delivers you to the site you specify or best fits your profile.*** (Pg. 4 l. 3-9).

34. It would have been obvious to one skill in the art to incorporate the teachings of medscape into Papierniak to further personalize the system based on the users preferences as the basis of the invention.

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 1035185 A2 Walter et al, September 13, 2000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DENNIS RUHL
PRIMARY EXAMINER

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